

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/540,343 10/06/95 HALLAHAN

D ARCD:194

EXAMINER

MILNE, A

ART UNIT

PAPER NUMBER

18N2/0802

1804

DATE MAILED:

08/02/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

for restriction purposes only

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire month(s), **30** days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims **1 - 32** are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims **1 - 32** are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other _____

EXAMINER'S ACTION

Serial Number: 08/540,343

2

Art Unit: 1804

Claims 1-32 are currently pending in U.S. Patent Application Number 08/540,343, filed 10-06-95.

A telephone call was made to Gary J. Sertich on 7-10-96 to request an oral election to the above restriction requirement, but did not result in an election being made.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-28, drawn to methods and processes of enhancing the effectiveness of radiotherapy and sensitizing cells to ionizing radiation, classified in Class 435, subclass 320.1, and Class 514, subclass 44.

II. Claims 29-32, drawn to a diagnostic process of involving a virus for assessing the effects to radiation, classified in Class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The claims of groups I and II are distinct given the many different technical considerations concerning diagnostic methods wherein observing whether an enhancement in radiation sensitivity is achieved *in vitro* versus the task of actually accomplishing the enhanced sensitivity in mammalian cells *in vitro* or *in vivo*. For example, should the claims encompass *in vivo* enhancement of sensitivity to ionizing radiation, then the skilled artisan must consider successful targeting and stability of the virus in an *in vivo* setting. Moreover, a literature search for the diagnostic

Serial Number: 08/540,343

3

Art Unit: 1804

methods of group II would not necessarily encompass methods of enhancing the sensitivity of tumor cells to radiation *in vitro* or *in vivo*.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication from the examiner should be directed to Andrew Milne, whose telephone number is (703) 308-4213. The examiner can normally be reached from 7:00 to 4:00 (Eastern Standard Time) Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacqueline Stone, can be reached at (703) 308-3153. The fax number for art unit 1804 is (703) 308-0294.

Any inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0196.

Serial Number: 08/540,343

4

Art Unit: 1804

Andrew Milne

J. Stone
7-10-96

J. Stone
JACQUELINE M. STONE
SUPERVISORY PATENT EXAMINER
GROUP 1800